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97 • 360 AUG 27 1997

No. ———

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

UNITED STATES SURGICAL CORPORATION,
Petitioner,

v.

ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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34 pp

QUESTIONS PRESENTED

1. Did this Court's holding in *Markman* v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), that the disputed construction of a patent claim is an issue for the court rather than the jury, apply only to "technical terms" and "words of art" and to issues of infringement?

2. Does a court satisfy its obligation to construe a patent claim when without guidance or limitation it sends a dictionary to the jury room?

LIST PURSUANT TO RULE 29.6

Petitioner is a publicly held Delaware corporation with no parent companies and no subsidiaries other than wholly owned subsidiaries.

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Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITION FOR A WRIT OF CERTIORARI

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit entered in this case January 3, 1997.

OPINIONS BELOW

The opinion of the United States District Court for the District of Connecticut is unreported and is reproduced in the Appendix at A. 39a. The initial order of affirmance by the Court of Appeals is reported at 48 F.3d 1237 (table) and is reproduced at A. 69a. Its initial order denying rehearing and rehearing *in banc* is unreported and is reproduced at A. 70a. This Court's orders granting certiorari, vacating the judgment of the Court of Ap-

peals, and remanding for further consideration in light of *Markman* v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), are reported at 116 S. Ct. 1562 and are reproduced at A. 71a and 72a. The Court of Appeals' opinion after remand from this Court is reported at 103 F.3d 1554 and is reproduced at A. 1a. The order of the Court of Appeals denying rehearing and rehearing *in banc* is unreported and is reproduced at A. 37a.

JURISDICTION

The judgment of the Court of Appeals was entered January 3, 1997. A. 1a. A timely petition for rehearing was denied May 30, 1997. A. 37a. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTES INVOLVED

Title 35 U.S.C. §§ 103, 112 and 282 are reproduced at A. 95a-99a.

STATEMENT

Petitioner, a manufacturer of surgical equipment, holds patents on the Endo Clip, a device used since 1989 by surgeons performing endoscopic surgery to make multiple closures of incisions in blood vessels through a tiny sealed tube (trocar). Such endoscopic apparatus, now often used in gall-bladder removals and other frequently-performed operations, has eliminated the need for more invasive procedures.

Respondents in 1991 began marketing their own endoscopic multiple-clip applier. Petitioner in 1992 brought suit against respondents in the United States District Court for the District of Connecticut for infringement of four claims contained in two of its patents. Respondents defended that the patents were not infringed and were invalid for obviousness.

A. Jury Interpretation of Disputed Claims.

The District Court recognized that "the parties intensely disputed the meaning of the claims," presenting "diametri-

cally opposed" positions. A. 61a. Respondent likewise explained that

> "There was a sharp dispute at trial on how a person of ordinary skill in the art would construe the claims. To be sure, each side's experts thought that the meaning of the claims was clear—but they construed the claims in ways that could not have been more divergent." [1]

At trial, petitioner submitted to the court proposed instructions to interpret for the jury the claims at issue. But the District Court refused to instruct the jury on what the claims meant; instead, "[t]he court instructed the jury to determine the meaning of the patent claims." A. 61a. The District Court's instruction to the jury was:

> "Because I have determined that there's a factual dispute here concerning the meaning of the patent claims, you must determine how the claims in this patent should be interpreted. You should interpret the language of the claim as one of ordinary skill in the art would do."

A. 92.[2] These instructions to the jury to interpret the claims applied to the issues both of infringement and of obviousness. A. 91a-94a.

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[1] Brief for Appellees, Nos. 94-1386 and 94-1219, U.S.C.A., Fed. Cir., at 28-29 (1994).

[2] In making its interpretation, the jury was told by the District Court that "In interpreting the language of the claims you should consider:

> "One, the ordinary meaning of the language used in the claim;
>
> "Two, the specifications in the patent;
>
> "Three, the prosecution history of the patent;
>
> "Four, the other claims in the patent;
>
> "Five, the prior art in the field,"

as well as expert testimony. A. 92a.

B. Sending the Jury a Dictionary.

After the jury began deliberations, it wrote a note to the judge requesting that a dictionary be sent to the jury room. Both parties objected. C.A.A. 686.[3] The District Court nevertheless sent the jury a copy of *Webster's New World Dictionary*. A. 67a. The jury then returned a verdict that one of petitioner's claims had been infringed, but that all four claims were invalid for obviousness. C.A.A. 31a, 35a-36a.

Petitioner moved for a new trial, objecting again to the District Court's failure to interpret the patent claims for the jury, and the jury's use of a dictionary. Petitioner argued that the jury's consulting a dictionary should be presumed prejudicial, but that if a showing of prejudice was required, the court should at least grant "an evidentiary hearing to examine jurors as to the words for which they consulted the dictionary."[4] The District Court responded that "Because the jury was properly instructed to consider the 'ordinary meaning' of the terms used in the patent claims, the court concludes that the court correctly provided the jury with a dictionary upon their request," and "U.S. Surgical has not established that the provision of the dictionary resulted in prejudice." A. 67a. The court denied a hearing on the effect of the dictionary and denied a new trial. A. 67a-68a.

C. First Affirmance by the Court of Appeals.

Petitioner renewed its objections on appeal. The United States Court of Appeals for the Federal Circuit (Newman,

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[3] Citations to "C.A.A." are to the appendix filed in the Court of Appeals.

[4] Reply to Defendants' Opposition to U.S. Surgical's Motion for Judgment as a Matter of Law and Motion for New Trial, at 27. Petitioner was precluded by a local rule from contacting any juror. Rules of the United States District Court for the District of Connecticut, Rule 12(e).

Bennett and Rader, JJ.), affirmed without any opinion. A. 69a. Rehearing was denied. A. 70a.

D. Vacatur and Remand by This Court.

Petitioner then petitioned this Court for certiorari, seeking review of "[w]hether patent claim construction for use in infringement and obviousness analysis is a matter exclusively for the court . . . or for the jury," and whether "refus[al] to apply the presumption of prejudice arising from the jury's use of extraneous matter, was in direct conflict with . . . decisions of other federal (and state) courts." Petition for Certiorari, *United States Surgical Corp.* v. *Ethicon, Inc.*, No. 94-2081, at i (1995). Petitioner noted that a petition for certiorari in another case, *Markman* v. *Westview Instruments, Inc.*, also raised the question whether construction of a patent claim was an issue for the court or the jury. See Petition for Certiorari, No. 94-2081, at 13-14 (1995); *cf.* Petition for Certiorari, *Markman*, *supra*, No. 95-26, at i (1995). This Court granted certiorari in *Markman*, 116 S. Ct. 40 (1995), and held petitioner's petition.[5]

On April 23, 1996, this Court decided *Markman*, holding that the interpretation of claims in a patent "is an issue for the judge, not the jury." 116 S. Ct. 1384, 1396 (1996). The following week, on April 29, 1996, this Court granted certiorari in the present case, vacated the judgment of the Court of Appeals, and remanded "for further consideration in light of *Markman* v. *Westview Instruments*, 517 U.S. —— (1996)." *United States Surgical Corp.* v. *Ethicon, Inc.*, 116 S. Ct. 1562 (1996), A. 72a.

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[5] Petitioner filed a brief *amicus curiae* in *Markman* to which two members of this Court made reference during the oral argument. Tr. of Oral Arg., *Markman* v. *Westview Instruments, Inc.*, No. 95-26 (Jan. 8, 1996), at 19, 23. Petitioner's brief argued, as this Court subsequently held in *Markman*, that construction of patent claims was an issue for the judge, not the jury.

E. The Court of Appeals' Reaffirmance.

After the remand from this Court, petitioner requested the Court of Appeals to remand to the District Court for a new trial in which the judge rather than the jury would construe the claims. But instead, the same panel of the Court of Appeals reaffirmed its previous judgment. A. 1a. In an opinion by Judge Newman, joined by Judges Bennett and Rader,[6] it held that in spite of this Court's remand, this Court's *Markman* holding was inapplicable because

> "U.S. Surgical has not shown that there are unclear or ambiguous technical terms or words of art or related aspects of claim scope whose 'construction' as requested by U.S. Surgical would negate the verdicts of obviousness. The jury was instructed, without objection, that the language of the claims was to have its plain meaning. There was no dispute as to the meaning of technical terms or words of art as used in either the prior art or the claims. The difference between the prior art and the claimed invention is a question of fact . . . and was not overruled by the Court's *Markman* decision."

A. 35a. The jury was presumed to have given the words of the claims their "plain meaning," the court held, and petitioner had failed to demonstrate any prejudice. A. 31a, 35a-36a.

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[6] Judge Newman had previously dissented at length from the Federal Circuit holding that was affirmed by this Court in *Markman*. See *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 999-1026 (Fed. Cir. 1995) (Newman, J., dissenting). Judge Rader also had declined to join the Federal Circuit's *Markman* majority, on grounds that the issue whether judge or jury was to construe patent claims was not properly presented. *Id.* at 998 (Rader, J., concurring). Judge Newman, with Judge Rader concurring, also had authored the Federal Circuit's earlier opinion, overruled in *Markman*, that had held patent-claim construction an issue for the jury. See *Tol-O-Matic, Inc.* v. *Proma Produkt-Und Marketing G.m.b.H.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991).

The Court of Appeals acknowledged that "[t]he issue was interpretation of these means-plus-function claims and their application to find if there was infringement by the Ethicon devices." A. 26a. The Court of Appeals held, however, that

> "Although claim construction may occasionally be necessary in obviousness determinations, when the meaning or scope of technical terms and words of art is unclear and in dispute and requires resolution in order to determine obviousness, in this case none of those rejected instructions was directed to, or has been shown reasonably to affect, the determination of obviousness."

A. 31a. The court said that "[t]here was no dispute concerning the structures described in the '420/'057 patents, or concerning the meaning of technical terms or words of art as used in the prior art or in the patents in suit," and that "[t]he jury was instructed that the technical terms had their plain meaning, as the district court mentioned in its opinion on the post-trial motions." A. 18a. The Court of Appeals reiterated several times that

> "the jury was not required to choose between alternative meanings of technical terms or words of art, or decide the scope of the claims, in deciding the question of obviousness. The factual findings of the scope and content of the prior art, the differences between the prior art and the claimed invention, the level of ordinary skill in the field of the invention, and the objective considerations, did not require 'construction' of these claims as set forth in the *Markman* decision of the Federal Circuit and the Supreme Court."

A. 19a-20a. Because it believed "there was no argument at trial as to the meaning of technical terms or words of art insofar as they concern the determination of obviousness," A. 18a, the Court of Appeals "affirmed, on the

ground of invalidity of the '420 and '057 patents based on obviousness." A. 4a.[7]

With respect to the District Court's approval of the jury's use of a dictionary, the Court of Appeals held that although such a practice is "not favored," A. 32a, "U.S. Surgical does not mention any terms that were used outside of their ordinary meaning," A. 32a, and "does not direct us to any actual or reasonably possible prejudice," A. 33a. Rehearing and rehearing *in banc* were denied. A. 37a.

REASONS FOR GRANTING THE WRIT

This case is before this Court for a second time because the Court of Appeals did not comply with this Court's mandate. On April 29, 1996, this Court granted certiorari, vacated the judgment of the Court of Appeals, and remanded for further consideration in light of *Markman*. 116 S. Ct. 1562, A. 72a. But after that remand, the same panel of the Court of Appeals reentered its judgment—announcing that *Markman*'s holding that patent claims are to be construed by the judge applies only to "technical terms" and "terms of art." The Court of Appeals held that in an obviousness determination, even when the construction of terms is "intensely disputed," A. 61a, if the words carry an "ordinary meaning" then the construction of patent claims is to be determined by the jury after all, and *Markman* has no application.

No such exception is to be found in this Court's *Markman* opinion, and this Court's vacating of the Court of Appeals' prior judgment confirms that no such exception was ever contemplated. The text and reasoning of the *Markman* opinion utterly refute it. *Markman* plainly

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[7] The Court of Appeals, like the District Court, refrained from providing any construction of the claims itself. Instead, it held that "the jury was not required to choose between alternative meanings of technical terms," A. 19a, and "there was substantial evidence from which a reasonable jury could have held that the claimed subject matter would have been obvious to a person of ordinary skill in the field at the time the invention was made," A. 36a.

applies to all disputed constructions of patent claims, and is not limited to only those that courts may choose to characterize as "terms of art" or "technical terms." And whether a claim is obvious cannot be determined without first construing what it means. The judgment of the Court of Appeals should either be summarily vacated once more and the case remanded for a new trial, or the case set for briefing and argument in this Court to remove the broad exception to *Markman* this decision has created. If the case is set for argument, this Court should also resolve the split in the circuits created by the Court of Appeals' further holding that over objection a court may provide a jury a dictionary without guidance or limitation, and an objecting party must bear the usually-impossible burden of proving prejudice.

I. THE COURT OF APPEALS FAILED TO FOLLOW THE MANDATE OF THIS COURT.

In *Markman* v. *Westview Instruments, Inc.*, *supra*, this Court considered whether "the interpretation of a so-called patent claim . . . is a matter of law reserved entirely for the court." 116 S. Ct. at 1387. Unanimously, this Court held that it was. *Id.* at 1396.

This Court held the first petition for certiorari in this case for several months, until *Markman* had been decided.[8] This Court then vacated the judgment in the present case and remanded, directing the Federal Circuit to follow *Markman*. 116 S. Ct. 1562 (1996). This Court has explained that when it grants certiorari, vacates and remands, it does so because "intervening developments" (here specified by this Court to be the *Markman* decision)

> "reveal a reasonable probability that the decision below rests upon a premise that the lower court

[8] "We regularly hold cases that involve the same issue as a case on which certiorari has been granted and plenary review is being conducted *in order that* (if appropriate) they may be 'GVR'd' when the case is decided." *Stutson* v. *United States*, 116 S. Ct. 611, 613 (1996) (Scalia, J., dissenting) (emphasis in original).

> would reject if given the opportunity for further consideration."

Lawrence v. *Chater*, 116 S. Ct. 604, 607 (1996).

Nevertheless, the Court of Appeals after remand adhered once more to the same "premise"—the premise rejected by this Court that patent-claim interpretation is a function for the jury rather than the judge. The same Federal Circuit panel whose judgment this Court had vacated announced—in an opinion authored by the judge who had dissented for 27 pages from the holding this Court unanimously affirmed in *Markman*—a new exception to *Markman* that would assign disputed patent-claim interpretation to the jury after all, whenever the issue is obviousness or the court decides the words used in the claim are not "technical" nor "words of art." But obviousness is one of the most frequent defenses in patent litigation. *See Parker* v. *Flook*, 437 U.S. 584, 588 (1978). And patent claims often use ordinary words. By this decision this Court's *Markman* decision has been effectively negated, and patent-claim interpretation reassigned to the jury.

A. *Markman* Contains No Exception Limiting Its Rule to "Technical Terms" and "Words of Art."

This Court in *Markman* unambiguously decided the respective roles of judge and jury when a patent claim must be construed. That task, it held, is for the judge. 116 S. Ct. at 1396. This Court did not make that structural holding as to the respective functions of judge and jury depend on whether the claim affected an infringement claim or an obviousness defense, nor on whether the words of the claim seemed ordinary or technical. On the contrary, the Court began its unanimous *Markman* opinion by announcing that

> "We hold that the construction of a patent, *including* terms of art within its claim, is exclusively within the province of the court."

116 S. Ct. at 1387 (emphasis supplied). The trial court's duty, this Court held, was to construe *all* patent claims, "including" terms of art, but in no way limited to them. This Court indeed observed that "The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis." *Id.* at 1395. This Court added that "treating interpretive issues as purely legal will promote . . . intrajurisdictional certainty" through "uniformity in the treatment of a given patent." 116 S. Ct. at 1396.

Ironically, one of the arguments unsuccessfully advanced in *Markman* had been that "words of art," which often require weighing of extrinsic evidence, should be construed by the jury, even if ordinary words were for the judge. See Brief for Petitioners, *Markman* v. *Westview Instruments, Inc.*, No. 95-26, at 27-28 (1995). The author of the Court of Appeals' opinion in this case had relied in part on the same distinction in her dissent in *Markman*.[9] This Court explicitly rejected it.[10] Now, suddenly, the

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[9] Judge Newman in her dissent in *Markman* had argued that *terms of art in particular* required interpretation by the jury. See 52 F.3d at 1000 (dissenting opinion) ("there is often a factual dispute as to the meaning and scope of the technical terms or words of art"); *id.* at 1001 ("the legal effect or construction of the terms of a document, a matter of law, is not to be confused with resolution of disputes concerning the factual meaning of the terms"). The dissent also had denounced the Federal Circuit *Markman* majority's historical analysis as "egregious." *Id.* at 1010. See also *Tol-O-Matic, Inc.* v. *Proma Produkt-Und Marketing G.m.b.H.*, *supra*, 945 F.2d at 1550 (Newman, J.) ("When the meaning of a term in a patent claim is unclear, subject to varying interpretations, or ambiguous, the jury may interpret the term en route to deciding the issue of infringement."), *overruled by Markman*, 52 F.3d at 977, *aff'd*, 116 S. Ct. 1384.

[10] "Losing, then, on the contention that juries generally had interpretive responsibilities during the 18th century, Markman seeks a different anchor for analogy in the more modest contention that even if judges were charged with construing most terms in the patent, the art of defining terms

Court of Appeals has reverted to a supposed distinction between terms of art and ordinary words—but this time to support exactly the converse proposition: that it is ordinary terms that should be construed by juries, leaving only terms of art for the judge. The Court of Appeals has taken what had been treated as the situation most clearly calling for construction by the judge—construction of ordinary terms—and without analysis or authority converted it into an exception to the *Markman* rule, leaving *Markman* applicable only to what previously had been treated as the more doubtful category for judicial construction, words of art.

The Court of Appeals' error in limiting *Markman* to "words of art" and "technical terms" is highlighted by the facts of *Markman* itself. For the interpretation at issue in *Markman* was of the very ordinary word "inventory." Yet this Court concluded:

> "Accordingly, we hold that the interpretation of the word 'inventory' in this case is an issue for the judge, not the jury . . . ."

116 S. Ct. at 1396. This Court certainly did not base its holding on any characterization of "inventory" as a "technical term" or a "word of art." Indeed, often it is the legal significance of ordinary words that calls for the most acute judicial interpretation.[11] Nor did the *Markman* opinion's reasoning, which emphasized the historically structurally distinct roles of judge and jury, contain the slightest hint of the new exception the Court of Appeals has now created. Uniformity of patent-claim meaning will not survive if different juries are allowed to interpret

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> of art employed in a specification fell within the province of the jury. Again, however, Markman has no authority from the period in question . . . . [and] we have found no scholarly authority."

116 S. Ct. at 1392-93.

[11] "The words that drive the justices to consult dictionaries are rarely multisyllabic mindbenders." Stewart, *Looking Up the Law in the Dictionary*, 79 A.B.A.J. 46 (July 1993).

the same claims differently. And new disputes can be expected over whether particular terms are "words of art" or not.

B. *Markman* Contains No Exception for Claims Challenged for Obviousness.

The Court of Appeals held that "Claim construction is a matter of resolution of disputed meanings and technical scope . . . for use in the determination of infringement." A. 31a. Claim construction, it said, was "occasionally . . . necessary in obviousness determinations," but only "when the meaning or scope of technical terms and words of art is unclear." *Id.* But nothing in the language or logic of this Court's *Markman* decision confines its holding to infringement issues, or excludes defenses of obviousness. For obviousness, as for infringement, "Analysis begins with a key legal question—*what* is the invention *claimed?*" *Panduit Corp.* v. *Dennison Mfg. Co.*, 810 F.2d 1561, 1567 (Fed. Cir.) (emphasis in original), *cert. denied*, 481 U.S. 1052 (1987); see also *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 1046 (1997) ("it is the claim that defines the invention"). To determine obviousness, "differences between the prior art and the claims at issue are to be ascertained." *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966). "[C]omparison of the prior art with *properly interpreted* claims is required." *Panduit, supra*, 810 F.2d at 1576 (emphasis supplied).

The Court of Appeals' belief that petitioner could not show prejudice from the judge's failure to construe the claims, and that petitioner's detailed proposed instructions were "redundan[t]" of the claim language, A. 31a, reflects a basic misunderstanding both of this Court's *Markman* holding and of the record. First, because the jury rather than the judge construed all the patent claims on which the case depended, the trial was structurally flawed. Second, because the jury rendered a general verdict, there is no way of knowing what errors of claim interpretation

it may have committed. Finally, the record shows that, as the District Court acknowledged, "the parties intensely disputed the meaning of the claims." A. 61a. Respondents' defense at trial was to paint petitioner's patents as either too narrow to be infringed, or so broad and all-encompassing as to be obvious. It was essential to petitioner, therefore, for the jury to be instructed on exactly what the claims did and did not include. Because the judge refused to give the jury any interpretation at all, respondents were left free to argue to the jury, and did so, that the claims included "everything" and were so ludicrously broad as to be obvious.[12] The Court of Appeals cited as examples of "redundan[t]" instructions only a selected few of the very extensive proposed instructions that the trial court rejected, omitting mention of many others, all of which would have prevented respondents' mischaracterizations of their breadth. See, *e.g.*, A. 86a-90a. "Each element contained in a patent claim is deemed material to defining the scope of the patented invention . . . ." *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, *supra*, 117 S. Ct. at 1049.

Nothing in *Markman* suggests that patent-claim interpretation is to be reassigned to the jury if a defense of obviousness is raised. And it is difficult to imagine

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[12] Respondents' counsel thus told the jury in closing argument:

> "Any jaws, any pusher bar, any feed system, any escapement, that's what they say is described in their patents, and then, of course, because it's a means plus function claim, they also get the equivalents. Any jaws plus equivalent. *That's everything.* There's nothing left, if that's the way you construe a patent. But *if that's what the patent is*, it doesn't matter what they invented. *It's really just an obvious conception.* It's an invalid patent."

C.A.A. 673 (emphasis supplied). Although respondents thus were left free to ask the jury to find, for example, that petitioner's clip-closing claim element covered "any jaws," petitioner had asked the District Court to instruct the jury that the claim was limited to "flexible opposing jaws and a distally moving cam channel." A. 80a.

how as a practical matter such a distinction could be implemented. A vast number of patent cases—like this one—include issues both of infringement and of obviousness, and require the same claims to be interpreted for both purposes. The Court of Appeals' holding means that the same claims would have to be interpreted for infringement issues by the judge, but for obviousness issues, perhaps differently, by a jury. Moreover, this Court in *Markman*, in addition to noting that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors," 116 S. Ct. at 1395, also emphasized that leaving claim interpretation to juries could lead to inconsistent holdings "in every new court in which a patent might be litigated," *id.* at 1396. "Uniformity would . . . be ill served by submitting issues of document construction to juries." *Id.* That same prospect of inconsistent holdings by different juries construing the same words would be no less when patent claims are challenged for obviousness.

C. *Markman* Is Not Satisfied by Sending the Jury a Dictionary.

The command of *Markman* that trial judges must construe patent claims surely was not satisfied by the District Court's simply telling the jurors that the interpretation duty was theirs and giving them a dictionary. See A. 67a. Such "do it yourself" patent-claim interpretation not only violates this Court's holding in *Markman*. It also conflicts with holdings in many federal circuits and state courts that it is error for a jury to use a dictionary during its deliberations, and reversible error unless established to be harmless. See pp. 17-22, *infra*. Moreover, it fundamentally ignores the basic rule that patent-claim terms must be interpreted not as bare words, but in context. "In patent law, a word ('teeth'; 'hinge'; 'ledge') means nothing outside the claim and the description in the specification."

Panduit Corp. v. *Dennison Mfg. Co., supra*, 810 F.2d at 1576.[13] The Court of Appeals' holding that the jury, wholly unguided, could use a dictionary in determining the meaning of patent-claim terms also is wholly at odds with the fundamental rule of patent law that those terms are to be construed, not as a layperson would, but rather as they are understood by a person of ordinary skill in the art. See, *e.g.*, *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995), *aff'd*, 116 S. Ct. 1384 (1996); 35 U.S.C. § 103.

Indeed, the fact that the jury here resorted to a dictionary underscores that the jury was playing a role outside its proper function. Interpreting terms of legal import by consulting dictionaries—and recognizing particular dictionaries' limitations[14]—is a function that *judges* perform all the time. *See, e.g., MCI Telecommunications Corp.* v. *American Tel. & Tel. Co.*, 512 U.S. 218, 225-28 (1994); *Ernst & Ernst* v. *Hochfelder*, 425 U.S. 185, 199 (1976); Note, *Looking It Up: Dictionaries and Statutory Interpretation*, 107 HARV. L. REV. 1437 (1994). The dictionary misuse in this case came about exactly because the jury was being asked to perform the judicial role of construing the text of a legal document. And because the jury's conclusions as to the

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[13] See also *Nix* v. *Hedden*, 149 U.S. 304, 306-07 (1893) (rejecting dictionary definition of tomato in construing Tariff Act); *Mayhue* v. *St. Francis Hosp. of Wichita, Inc.*, 969 F.2d 919, 925 (10th Cir. 1992) (new trial appropriate when the jury had looked at a dictionary whose definitions were too broad and unsuitable to reflect the applicable law).

[14] Particularly in the hands of lay jurors, a dictionary may "convey[] the existence of certainty—or 'plainness'—when appearance may be all there is." Randolph, *Dictionaries, Plain Meaning, and Context in Statutory Interpretation*, 17 HARV. J.L. & PUB. POL. 71, 72 (1994). This Court also has pointed out that some dictionaries are more useful or reliable than others. See *MCI Telecommunications Corp.* v. *American Tel. & Tel. Co.*, 512 U.S. 218, 228 n.3 (1994). The particular dictionary the district judge selected has been cited by this Court only once. *Meese* v. *Keene*, 481 U.S. 465, 478 n.11 (1987).

correct construction are concealed within its verdict, there is no way to exercise meaningful appellate review of its conclusion. Tacitly acknowledging this, the Court of Appeals used the standard of review applied to factual rather than legal determinations, and held simply that "there was substantial evidence from which a reasonable jury could have" reached its result. A. 36a.

II. THE DECISION CONFLICTS WITH HOLDINGS OF FIVE OTHER CIRCUITS AND SEVEN STATE COURTS THAT JURY USE OF A DICTIONARY IS REVERSIBLE ERROR UNLESS ESTABLISHED TO BE HARMLESS.

Part of the basic process due parties to a judicial trial is that the jury is to weigh only the evidence admitted and made part of the record at the trial, not dictionaries and other extra-record texts. "The rule that nothing which has not been introduced into evidence may go to the jury room is fundamental." *United States* v. *Siragusa*, 450 F.2d 592, 595 (2d Cir. 1971), *cert. denied*, 405 U.S. 974 (1972). A jury is to decide "solely on the evidence before it." *Smith* v. *Phillips*, 455 U.S. 209, 217 (1982); *cf.* also Fed. R. Evid. 103(c) ("In jury cases, proceedings shall be conducted, to the extent practicable, so as to prevent inadmissible evidence from being suggested to the jury."). "[D]ictionaries fall within the category of extrinsic evidence . . . ." *Vitronics Corp.* v. *Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996).

For a jury to consult a dictionary or other reference text not in evidence is held to be such a serious infraction of basic due process that the cases usually analyze it as an instance of jury misconduct. But here, ironically, the jury did not act surreptitiously or on its own: instead, it was actually furnished the dictionary by the court—and over the objections of both parties. The court gave the jury no guidance on what use it could make of the dictionary, nor any limitations on its use. And petitioner was not allowed to inquire into the dictionary's effect.

A number of federal and state courts hold that the jury's use of a dictionary creates a presumption of reversible error. An often-cited decision on the subject, written by the late Justice Brennan of this Court when he sat in New Jersey, emphasized that

> "The stringency of the rule is not mere formalism; the rule is 'imperatively required to secure verdicts based on proofs taken openly at the trial, free from all danger of extraneous influences.' "

Palestroni v. *Jacobs*, 10 N.J. Super. 266, 271, 77 A.2d 183, 185 (App. Div. 1950), quoting in part *Lamphear v. MacLean*, 176 App. Div. 473, 476, 162 N.Y.S. 432, 434 (1916). His opinion for the court pointed out that

> "The use by a jury of a dictionary has an obvious potentiality for harmful influence. The danger is ever present it may be employed to ascertain meanings not just of one but of many words used in the court's charge or in papers in evidence."

Palestroni, supra, 10 N.J. Super. at 273, 77 A.2d at 186. Quoting that opinion, the highest court of Maryland in a case in which jurors had consulted a dictionary agreed that

> "the test whether a new trial will be granted is whether the extraneous matter *could have* a tendency to influence the jury in arriving at its verdict in a manner inconsistent with the legal proofs and the court's charge. If the extraneous matter *has that tendency* on the face of it, a new trial should be granted without further inquiry as to its actual effect."

Wernsing v. *General Motors Corp.*, 298 Md. 406, 419, 470 A.2d 802, 808-09 (1984) (emphasis supplied), quoting *Palestroni, supra*, 10 N.J. Super. at 271, 77 A.2d at 185. "The test is capacity of the irregular matter to influence, not whether influence in fact resulted." *Palestroni, supra*, 10 N.J. Super. at 272, 77 A.2d at 186. See also, *e.g.*, *Glage* v. *Hawes Firearms Co.*, 226 Cal. App. 3d 314, 323, 276 Cal. Rptr. 430, 434 (1990) ("[i]t is well established that a juror's reference to a dictionary for the defi-

nition of a term used in an instruction constitutes misconduct" and creates a "presumption of prejudice"); *Daniels* v. *Barker*, 89 N.H. 416, 420, 200 Atl. 410, 415 (1938) (when jury obtained a dictionary "the verdict is set aside, without proof that the jury gave it any weight"); *State* v. *Holmes*, 17 Or. App. 464, 476, 522 P.2d 900, 905 (1974) ("we must assume that prejudice flowed" when court over objection furnished jury a dictionary); *State* v. *Ott*, 111 Wis. 2d 691, 696, 331 N.W.2d 629, 632 (Ct. App. 1983) (reversing when juror brought in a dictionary definition because "the probable effect upon a hypothetical average jury would be prejudicial").

The Second Circuit is in sharp disagreement with what the Federal Circuit held in this case. The Second Circuit holds:

> "We have recognized that 'extra-record information that comes to the attention of a juror is "presumptively prejudicial." ' "

United States v. *Weiss*, 752 F.2d 777, 782-83 (2d Cir.) (accounting textbook), *cert. denied*, 474 U.S. 944 (1985), quoting *United States* v. *Hillard*, 701 F.2d 1052, 1064 (2d Cir.), *cert. denied*, 461 U.S. 958 (1983), and *Remmer* v. *United States*, 347 U.S. 227, 229 (1954). To rebut the presumption of prejudice, the Second Circuit holds, there must be "an affirmative showing . . . that the information was harmless." *United States* v. *Weiss*, *supra*, 752 F.2d at 783 (allowing verdict to stand after "an exhaustive evidentiary hearing").

The Ninth Circuit's position is the same. "A defendant is entitled to a new trial when the jury obtains or uses evidence that has not been introduced during trial if there is 'a reasonable possibility that the extrinsic material could have affected the verdict.' " *Dickson* v. *Sullivan*, 849 F.2d 403, 405 (9th Cir. 1988), quoting *Marino* v. *Vasquez*, 812 F.2d 499, 504 (9th Cir. 1987). Thus when some jurors had consulted a dictionary, the Ninth Circuit held that arguments that their doing so had been harmless "are insufficient to meet [the] burden of proving that the error

was harmless beyond a reasonable doubt." *Marino* v. *Vasquez, supra,* 812 F.2d at 506.

Other federal courts of appeals, and state courts as well, hold that reversal is required for jury use of a dictionary that is not in evidence unless an evidentiary hearing or other clear showing establishes that it had no effect. Thus the Sixth Circuit requires that when jury use of a dictionary is known, "the trial judge should determine whether the jury actually substituted the dictionary definition of a legal term for that given in the instructions." *United States* v. *Griffith,* 756 F.2d 1244, 1252 (6th Cir.), *cert. denied,* 474 U.S. 837 (1985). See also *Rodriguez y Paz* v. *United States,* 473 F.2d 662, 663 (5th Cir.) ("[t]he trial judge has conducted an evidentiary hearing as directed," concluding "that there is no reasonable possibility that the books—brought to the court by an alternate juror who did not participate in the jury's deliberations—affected the verdict"), *cert. denied,* 414 U.S. 820 (1973); *United States* v. *Duncan,* 598 F.2d 839, 866 (4th Cir.) (court after inquiry concluded that the foreman "had immediately squelched all discussion of the dictionary definitions"), *cert. denied,* 444 U.S. 871 (1979).[15]

What all these courts presume to be prejudicial, the Federal Circuit presumes is not. What at least five Circuits and seven state courts unhesitatingly treat as misconduct, the Federal Circuit approves. No court until now has ever allowed a verdict to stand when a jury used a dictionary, the use the jury made of it was not known, and a request for hearing to determine what use occurred was denied.

What the Court of Appeals has upheld here rejects all those cases. The Court of Appeals held that "The district court did not commit prejudicial error by providing the

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[15] *But cf. United States* v. *Martinez,* 14 F.3d 543, 551 (11th Cir. 1994) ("[s]tanding alone, the jury's use of the dictionary would not warrant a new trial," although "in light of the circumstances" its having done so "taint[ed] its deliberations").

dictionary," A. 33a, because petitioner "does not direct us to any actual or reasonably possible prejudice, or any suggestion that the jury disregarded the court's instruction on the law of obviousness, or the plain meaning of the terms used in the claims and the prior art." *Id.*[16] The Court of Appeals thus held that the burden of establishing prejudice rested on petitioner—even though petitioner was prohibited from contacting any juror, so that petitioner could not even learn which words the jury had looked up.[17] To require a party to prove something, but deny it the opportunity to do so, is a fundamental due process violation. *Brinkerhoff-Faris Trust & Sav. Co.* v. *Hill,* 281 U.S. 673, 678 (1930); *cf. Remmer* v. *United States, supra,* 347 U.S. at 229. When a jury consults a dictionary, "[t]o require the losing party to prove actual prejudice would place a difficult and unjust burden on him." *Daniels* v. *Barker, supra,* 89 N.H. at 421, 200 Atl. at 415.

Moreover, petitioner certainly did make a showing of likely prejudice from the dictionary. No one except the jurors knows what or how extensive a use they made of it. Not only the terms of the disputed claims, but definitions of other words important to the verdict could have been consulted. For example, even the word "obvious" in

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[16] Exactly that reasoning was rejected in *State* v. *Ott, supra*:

> "[W]e differ with the trial court's analysis. In its oral decision, the trial court stated: 'I don't know how a jury would ignore those [written] instructions [in light of the instruction that requires the jury to follow the law as given in the court's instructions and nothing else.].' We believe the very fact that a juror brought in a dictionary definition to the second day of deliberations and made that fact known to the other jurors contradicts the trial court's conclusion."

111 Wis. 2d at 696, 331 N.W.2d at 631-32 (second and third brackets in original).

[17] See Rules of the United States District Court for the District of Connecticut, Rule 12(e). Respondents also argued that "[s]ince we already know that the court submitted a dictionary to the jury, Rule 606(b) [Fed. R. Evid.] bars any inquiry into how the dictionary was used." Brief for Appellees, *supra* n.1, at 34-35.

the dictionary the court provided was defined in a manner far different from the meaning assigned that term in patent law.[18]

The Federal Circuit's holding creates not only a circuit conflict but a particular anomaly for the district court in this case. The Second Circuit, in which this district court sits, reverses cases in which jurors consult a dictionary unless harmlessness is established by an evidentiary showing. *United States* v. *Weiss*, *supra*. But because of this Federal Circuit holding, the same district court now has been authoritatively instructed by two different reviewing courts of appeals that it may not provide jurors a dictionary—*except* for certain claim interpretations in patent cases—ironically, the very category of cases in which this Court specifically held in *Markman* that claim interpretation is for the judge.[19]

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[18] *Webster's New World Dictionary* 937 (V. Neufeldt 3d College ed. 1988) defines "obvious" as "easy to see or understand; plain; evident." But "obvious" in patent law means that "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Relevant to "obviousness" in patent law are "secondary considerations" such as "commercial success, long felt but unresolved needs, failure of others," none of which appears in dictionary definitions of "obvious." See *Graham* v. *John Deere Co.*, *supra*, 383 U.S. at 17-18.

[19] To avoid just such anomalies the Federal Circuit ordinarily follows the law of the regional circuit in procedural matters:

> "Where, as here, a procedural question that is independent of the patent issue is in dispute, practitioners within the jurisdiction of a particular regional circuit court should not be required to practice law and to counsel clients in light of two different sets of law for an identical issue due to the different routes of appeal. An equal, if not more important, consideration is that district judges also should not be required to decide cases in this fashion."

Panduit Corp. v. *All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574 (Fed. Cir. 1984) (footnote omitted).

III. THE ISSUES ARE IMPORTANT.

This Court in *Markman* emphasized the importance of uniformity in patent-claim construction, which would be destroyed if the meaning of patent claims were left to the variable verdicts of juries. See 116 S. Ct. at 1396. An end of that uniformity and predictability is assured by the Federal Circuit's decision here, which would leave much of this Court's *Markman* holding a dead letter.

The exception the Court of Appeals creates for disputes about ordinary words used in a patent claim affecting obviousness removes many, perhaps most, patent cases from the *Markman* rule. Patent claims are commonly challenged for obviousness, and "words in a claim are generally given their ordinary and customary meaning." *Vitronics Corp.* v. *Conceptronic, Inc., supra*, 90 F.3d at 1582; *see also Hoechst Celanese Corp.* v. *BP Chemicals Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir.), *cert. denied*, 117 S. Ct. 275 (1996). If claim construction in all such cases now is to be left to juries, then appellate review will be confined—as the Court of Appeals confined it in this case, see A. 10a, 20a—merely to determining whether there was sufficient evidence to support the jury's verdict, rather than the *de novo* appellate review applied to legal rulings.

Until now, complying with *Markman*, district judges throughout the country had been construing all patent claims, including those using ordinary words and those at issue in obviousness cases.[20] This decision instructs them not to do so. It also invites a whole new category of disputes in patent litigation over whether or not a particu-

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[20] *E.g., Caterpillar Inc.* v. *Detroit Diesel Corp.*, 961 F. Supp. 1249, 1257 (N.D. Ind. 1996) (judge construed "engaged"); *P.A.T., Co.* v. *Ultrak, Inc.*, 948 F. Supp. 1506, 1515 (D. Kan. 1996) (judge construed "vehicle" in obviousness defense); *GMI Holdings, Inc.* v. *Stanley Door Systems, Inc.*, 943 F. Supp. 1420, 1428 (N.D. Ohio 1996) (judge construed "directly" and "transmit"); *Thorne EMI North America, Inc.* v. *Intel Corp.*, 936 F. Supp. 1186, 1190, 1196-99 (D. Del. 1996) (judge construed "gap" and "substantially").

lar term in a claim is to be treated as a "technical term" or "word of art," and hence, in spite of *Markman*, left to be construed by a jury. And by allowing juries uncontrolled use of a dictionary in the jury room, it creates a departure from a heretofore recognized prohibition that applies not just to patent litigation, but in cases of all kinds.

The Federal Circuit's holding not only revises *Markman* without warrant. It also fails to follow the clear mandate of this Court when the Federal Circuit's earlier judgment was vacated and the case remanded for application of *Markman*. It is of course essential to the functioning of the federal judiciary that subordinate courts adhere to this Court's mandates. *Cf. Yates* v. *Aiken*, 484 U.S. 211, 214 (1988) ("[w]e granted certiorari because we were concerned that the South Carolina Supreme Court had not fully complied with our mandate"); *Yates* v. *Evatt*, 500 U.S. 391, 400 (1991) ("we granted certiorari to review this case a third time"); *United States* v. *Sharpe*, 470 U.S. 675, 681 (1985) (granting certiorari for second time and reversing after court of appeals responded on remand, 712 F.2d 65 n.1 (4th Cir. 1983), that "[h]ad the Supreme Court felt that a reversal was in order, it could and would have said so"); *Remmer* v. *United States*, 350 U.S. 377, 379 (1956) ("This case is here for the third time. . . . The District Court's limit of our mandate, it seems to us, is hardly warranted by the language of the opinion . . . ."); *Baltimore & O.R.R.* v. *United States*, 279 U.S. 781, 785 (1929); *In re Sanford Fork & Tool Co.*, 160 U.S. 247, 255-56 (1895). A reminder of that fundamental duty is appropriate here.

CONCLUSION

For the reasons stated, certiorari should be granted, the judgment of the Court of Appeals vacated again, and the case remanded for a new trial in which the patent claims are construed by the judge; alternatively, certiorari should be granted and the case set for argument.

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August 27, 1997